

REMARKS

Fifty claims were originally filed in the present Application, and claims 51 through 65 were subsequently added. Claims 1-3, 5-6, 11-17, 22-26, 28-29, 34-40, 45-51, 55-56, 58-62, and 64 currently stand rejected under 35 U.S.C. §102, and claims 4, 7-10, 18-21, 27, 30-33, 41-44, 52-54, 57, 63, and 65 currently stand rejected under 35 U.S.C. §103. Claims 1 and 24 are amended herein. Reconsideration of the Application in view of the foregoing amendments and the following remarks is respectfully requested.

New Grounds of Rejection

In paragraph 18 of the present Office Action, the Examiner states that “the arguments with respect to claims 1 and 24 are based upon newly added subject matter.” Applicants respectfully disagree. As stated in the prior Response to Office Action which amended claims 1 and 24, “the foregoing amendments are supported by existing dependent claims 56 and 57, and therefore do not necessitate a new search.” Applicants therefore submit that the amendments to claims 1 and 24 do not constitute “newly added subject matter”.

In addition, in paragraph 18, the Examiner also states that “Applicant’s arguments with respect to claims 1-47 have been considered but are moot in view of the new ground(s) of rejection.” In light of the foregoing new grounds of rejection, Applicants submit that the finality of the present Office Action is not appropriate because Applicants have not had an opportunity to respond to the new grounds of rejection on their merits. Applicants therefore respectfully

request the Examiner to treat the present final Office Action as a non-final Office Action, so that Applicants may have an opportunity to adequately discuss and respond to the new grounds of rejection.

35 U.S.C. § 102(e)

In paragraph 4 of the Office Action, the Examiner rejects claims 1-3, 5-6, 11-17, 22-26, 28-29, 34-40, 45-46 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,147,742 to Bell et al. (hereafter Bell). The Applicants respectfully traverse these rejections.

“For a prior art reference to anticipate in terms of 35 U.S.C. §102, every element of the claimed invention must be *identically* shown in a single reference.” *Diversitech Corp. v. Century Steps, Inc.*, 7 USPQ2d 1315, 1317 (CAFC 1988). The Applicants submit that Bell fails to identically teach every element of the claims, and therefore, does not anticipate the present invention.

Regarding the Examiner’s rejection of independent claims 1 and 24, Applicants respond to the Examiner’s §102 rejection as if applied to amended independent claims 1 and 24 which are amended herein to recite “*said image pump being implemented separately from said image source and said service provider, in a non-integral manner, for transferring said image data from said image source to said service provider*” which are limitations that are not taught or suggested either by Bell or by the Examiner’s citations thereto. Applicants submit that the foregoing amendments are supported by existing claim 51, and therefore do not necessitate a new search.

Bell essentially teaches an automatic photofinishing system without any intermediary image pump between the image data source and the photofinishing system. Applicants therefore submit that Bell fails to disclose an image pump that is "implemented separately from said image source and said service provider, *in a non integral manner*, for transferring said image data from said image source to said service provider," as recited by Applicants in amended claims 1 and 24. Applicants therefore submit that the rejections under 35 U.S.C. § 102(e) are improper.

Regarding the Examiner's rejection of dependent claims 2-3, 5-6, 11-17, 22-23, 25-26, 28-29, 34-40, 45-46, for at least the reasons that these claims are directly or indirectly dependent from respective independent claims whose limitations are not identically taught or suggested, the limitations of these claims, when viewed through or in combination with the limitations of the respective independent claims, are also not identically taught or suggested. Applicants, therefore, respectfully request reconsideration and allowance of dependent claims 2-3, 5-6, 11-17, 22-23, 25-26, 28-29, 34-40, 45-46 so that these claims may issue in a timely manner.

Because a rejection under 35 U.S.C. §102 requires that each claimed limitation be *identically* taught by a cited reference, and because the Examiner fails to cite Bell to identically teach the claimed invention, Applicants therefore respectfully request reconsideration and allowance of claims 1-3, 5-6, 11-17, 22-26, 28-29, 34-40, 45-46 so that these claims may issue in a timely manner.

In paragraph 6 of the Office Action, the Examiner rejects claims 48-51, 55-56, and 58-61 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 5,974,401 to Enomoto et al. (hereafter Enomoto). The Applicants respectfully traverse these rejections.

As previously stated, “For a prior art reference to anticipate in terms of 35 U.S.C. §102, every element of the claimed invention must be *identically* shown in a single reference.” *Diversitech Corp. v. Century Steps, Inc.*, 7 USPQ2d 1315, 1317 (CAFC 1988). The Applicants submit that Enomoto fails to identically teach every element of the claims, and therefore, does not anticipate the present invention.

Enomoto essentially teaches providing image data from an input device to a user’s “*personal computer*” for processing and generation of “print order data”. The personal computer may then send the processed image data and the print order data to a photofinisher for processing (column 1, line 52 to column 2, line 31). Apparently, the Examiner analogizes the personal computer of Enomoto to Applicants’ “image pump”. Applicants respectfully disagree with this interpretation of Enomoto.

Applicants submit that, unlike a personal computer with significant processing power such as that disclosed by Enomoto, claims 1 and 24 recite an image pump that is implemented *without an internal processor* to thereby achieve an economical and simplified device configuration. Applicants submit that, in many embodiments, implementing their “image pump” as a personal

computer may result in a device that is excessively large in terms of size, complexity, and manufacturing costs.

Applicants submit that Enomoto nowhere teaches or discusses a simplified configuration for the personal computer device, such as that claimed in Applicants' claims 1 and 24 which now recite an image pump that is economically implemented "in a simplified configuration without an internal processor" to more clearly emphasize the simplified design of this embodiment of Applicants' invention.

With regard to independent claims 48, 49, and 51, Applicants submit that these independent claims also include additional limitations that are not taught or disclosed by Enomoto. For example, Applicants submit that Enomoto fails to teach a service provider "*reviewing said image data and said customer account information for accuracy*" as claimed by Applicants in claim 48.

With regard to claim 50, "means-plus-function" language is utilized to recite elements and functionality similar to those recited in claims 1 and 24, as discussed above. Applicants therefore incorporate those remarks by reference with regard to claim 50. In addition, the Courts have frequently held that "means-plus-function" language, such as that of claim 50, should be construed in light of the Specification. More specifically, means-plus-function claim elements should be *construed to cover the corresponding structure, material or acts described in the specification*, and equivalents thereof.

Applicants respectfully submit that, in light of the substantial differences between the teachings of Enomoto and Applicants' invention as disclosed in the Specification, claim 50 is therefore not anticipated or made obvious by the teachings of Enomoto. Applicants specifically direct the Examiner's attention to Applicants' discussions of FIGS. 1, 2, 3, and 8 (Specification, page 6, line 27 through page 9, line 7, and page 13, line 26 through page 14, line 25) which describe in further detail the Applicants' claimed "means for sending said image data to an image pump" and "means for sending said image data to said service provider utilizing said image pump."

Regarding the Examiner's rejection of dependent claims 55-56, and 58-61, for at least the reasons that these claims are directly or indirectly dependent from respective independent claims whose limitations are not identically taught or suggested, the limitations of these claims, when viewed through or in combination with the limitations of the respective independent claims, are also not identically taught or suggested. Applicants, therefore, respectfully request reconsideration and allowance of dependent claims 55-56, and 58-61 so that these claims may issue in a timely manner.

With regard to claim 56, Applicants respectfully submit that Enomoto nowhere teaches a "said image source includes an image-source processor device that downloads and executes an image pump manager program from said image pump" as recited in claim 56. Applicants therefore request the Examiner to reconsider and withdraw the rejection of claim 56.

With regard to claim 60, the Examiner states that “Enomoto discloses ... determining if the image data and customer information have errors”, and cites “column 7, lines 4-8” of Enomoto as support. Applicants respectfully submit that column 7, lines 4-8 of Enomoto nowhere teaches “*said photography service provider checking said image data for formatting errors and comparing said customer account information with local customer information records for account errors*” as recited in claim 60. Applicants therefore request the Examiner to reconsider and withdraw the rejection of claim 60.

Because a rejection under 35 U.S.C. §102 requires that each claimed limitation be *identically* taught by a cited reference, and because the Examiner fails to cite Enomoto to identically teach the claimed invention, Applicants therefore respectfully request reconsideration and allowance of claims 48-51, 55-56, and 58-61, so that the present Application may issue in a timely manner.

In paragraph 8 of the Office Action, the Examiner rejects claims 62 and 64 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,167,469 to Safai et al. (hereafter Safai). The Applicants respectfully traverse these rejections.

As previously stated, “For a prior art reference to anticipate in terms of 35 U.S.C. §102, every element of the claimed invention must be *identically* shown in a single reference.” *Diversitech Corp. v. Century Steps, Inc.*, 7 USPQ2d 1315, 1317 (CAFC 1988). The Applicants submit that Safai fails to identically

teach every element of the claims, and therefore, does not anticipate the present invention.

With regard to claims 62 and 64, the Examiner states that “Safai discloses . . . reviewing the order and providing services to the user”, and cites “column 7, lines 4-8” of Safai as support. Applicants respectfully submit that column 15, lines 17-58 of Safai nowhere teaches “*reviewing said image data and said customer account information for accuracy*” as recited in claim 62.

Regarding the Examiner’s rejection of dependent claims 63-65, for at least the reasons that these claims are directly dependent from independent claim 62 whose limitations are not identically taught or suggested, the limitations of these claims, when viewed through or in combination with the limitations of the respective independent claims, are also not identically taught or suggested. Applicants, therefore, respectfully request reconsideration and allowance of dependent claims 63-65 so that these claims may issue in a timely manner.

Because a rejection under 35 U.S.C. §102 requires that each claimed limitation be *identically* taught by a cited reference, and because the Examiner fails to cite Safai to identically teach the claimed invention, Applicants therefore respectfully request reconsideration and allowance of claims 62-65 so that the present application may issue in a timely manner.

Rejections under 35 U.S.C. §103

In paragraph 10 of the Office Action, the Examiner rejects claims 4 and 27 under 35 U.S.C. § 103(a) as being unpatentable over Bell in view of U.S. Patent No. 6,157,436 to Cok (hereafter Cok). Applicants respectfully traverse for at least the following reasons.

Applicants maintain that the Examiner has failed to make a *prima facie* case of obviousness under 35 U.S.C. § 103(a) which requires that three basic criteria must be met, as set forth in M.P.E.P. §2142:

"First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations."

The initial burden is therefore on the Examiner to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a).

With regard to claims 4 and 27, the Examiner states that Bell "does not clearly disclose the image source communicates with the image pump by wireless means". Applicants concur. The Examiner then points to Cok to remedy this deficiency, and concludes that "[i]t would have been obvious . . . to have modified Bell by the teaching of Cok" The Court of Appeals for the Federal Circuit has held that "obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some

teaching, suggestion, or incentive supporting the combination.” In re Geiger, 815 F.2d 686, 688, 2 U.S.P.Q.2d 1276, 1278 (Fed. Cir. 1987).

Applicants submit that the cited references nowhere teach or suggest a combination that would result in Applicants’ invention, and therefore the obviousness rejections under 35 U.S.C §103 are improper. Applicants respectfully request the Examiner to provide specific teachings *from the cited references* that establish an explicit motivation for combining these references, or alternately, to withdraw the foregoing rejections so that the rejected claims may issue in a timely manner.

In paragraph 12 of the Office Action, the Examiner rejects claims 7-10, 18-21, 30-33, 41-44 under 35 U.S.C. § 103(a) as being unpatentable over Bell in view of Enomoto. Applicants respectfully traverse for at least following reasons.

As discussed above, in order to establish a valid *prima facie* case of obviousness, the Examiner must show that the prior art references when combined teach *all the claimed limitations* of the present invention. Applicants respectfully submit that the cited references fail to disclose certain claimed limitations of rejected claims.

For at least the reasons that these claims are directly dependent from independent claims whose limitations are not identically taught or suggested, the limitations of claims 7-10, 18-21, 30-33, 41-44, when viewed through or in combination with the limitations of the respective independent claims, are also

not identically taught or suggested. Applicants, therefore, respectfully request reconsideration and allowance of dependent claims 7-10, 18-21, 30-33, 41-44 so that these claims may issue in a timely manner.

In addition, with regard to claims 18, 19, 41, and 42, the Examiner states that “Enomoto discloses the image pump (11) has a touchscreen for displaying the image data to the user”, and cites “column 6, lines 44-50” of Enomoto as support. Applicants respectfully submit that column 6, lines 44-50 of Enomoto nowhere teaches a “touchscreen” as recited in claims 44-50. Applicants therefore request the Examiner to reconsider and withdraw the rejection of these claims.

For at least the foregoing reasons, Applicants submit that the rejections of claims 7-10, 18-21, 30-33, 41-44 are improper, and respectfully request reconsideration and allowance of the rejected claims so that this claim may issue in a timely manner.

In paragraph 14 of the Office Action, the Examiner rejects claim 52 under 35 U.S.C. § 103(a) as being unpatentable over Enomoto in view of U.S. Patent No. 6,147,742 to Bell et al. (hereafter Bell).

As discussed above, in order to establish a valid *prima facie* case of obviousness, the Examiner must show that the prior art references when combined teach *all the claimed limitations* of the present invention. Applicants respectfully submit that the cited references fail to disclose certain claimed limitations of rejected claim 52.

For at least the reason that claim 52 is directly dependent from independent claim 51 whose limitations are not identically taught or suggested, the limitations of claim 52, when viewed through or in combination with the limitations of independent claim 51, are also not identically taught or suggested. Applicants, therefore, respectfully request reconsideration and allowance of dependent claim 52 so that this claim may issue in a timely manner.

In paragraph 15 of the Office Action, the Examiner rejects claims 53 and 57 under 35 U.S.C. § 103(a) as being unpatentable over Enomoto in view of Bell. Applicants respectfully traverse for at least the following reasons.

With regard to claim 57, Applicants respectfully submit that the Examiner has failed to address the limitations of “*a system user then limiting user interactions only to signaling said image pump to transfer said image data from said image pump to said photography service provider by physically activating basic image-data transfer means*”

Applicants further submit that the claimed “basic image-data transfer means” should be *construed to cover the corresponding structure, material or acts described in the specification*, and equivalents thereof. Applicants refer the Examiner to the discussion of FIG. 5(b) from page 10, line 29 to page 11, line 20 of the Specification which discusses a single pushbutton means for activating the image pump to transfer image data.

As previously cited, in order to establish a valid *prima facie* case of obviousness, the Examiner must show that the prior art references when combined teach *all the claimed limitations* of the present invention. As discussed above, the cited references fail to disclose certain claimed limitations, and Applicants therefore submit that the rejection of claim 48 under 35 U.S.C. § 103 is improper. Applicants respectfully request reconsideration of the rejected claims so that they may issue in a timely manner.

In paragraph 16 of the Office Action, the Examiner rejects claim 54 under 35 U.S.C. § 103(a) as being unpatentable over Enomoto in view of Bell, and further in view of Cok. Applicants respectfully traverse for at least the following reasons.

Applicants respectfully traverse the Examiner's assertion that modification of the device of Enomoto according to the teachings of Bell and Cok would produce the claimed invention. Applicants submit that Enomoto in combination with Bell and Cok fail to teach a number of the claimed elements of the present invention. Furthermore, Applicants also submit that neither Enomoto, Bell, nor Cok contain teachings for combining the cited references to produce the Applicants' claimed invention. The Applicants therefore respectfully submit that the obviousness rejections under 35 U.S.C §103 are improper.

Applicants submit that none of the cited references teaches a system with source transfer means that simultaneously includes “*a wireless connection, a hard-wired connection, and a form of removable storage*” that may utilized for “*alternately downloading said image data from said image source*”, and concurrently comprises destination transfer means that simultaneously includes “*a wireless connection, a hard-wired connection, and a form of removable storage*” that may utilized for “*alternately uploading said image data from said image pump to said photography service provider.*”

As previously cited, in order to establish a valid *prima facie* case of obviousness, the Examiner must show that the prior art references when combined teach *all the claimed limitations* of the present invention. As discussed above, the cited references fail to disclose certain claimed limitations, and Applicants therefore submit that the rejection of claim 54 under 35 U.S.C. § 103 is improper. Applicants respectfully request reconsideration and allowance of claim 54 so that this claim may issue in a timely manner.

In paragraph 17 of the Office Action, the Examiner rejects claims 63 and 65 under 35 U.S.C. § 103(a) as being unpatentable over Safai in view of Enomoto. Applicants respectfully traverse for at least the following reasons.

Applicants submit that neither Safai nor Enomoto teach a service provider “*reviewing said image data and said customer account information for accuracy*” as claimed by Applicants. Applicants therefore submit that the

rejection of claim 65 under 35 U.S.C. § 103(a) is improper, and respectfully request reconsider of the rejected claims, so that they may issue in a timely manner.

Combining References

Throughout the Office Action, the Examiner repeatedly states that “it would have been obvious to one of skill in the art” to combine various references. The Examiner then repeatedly provides various corresponding benefits that may result from such combinations as motivation for combining the references. Examples of this type of language may be found, for example, in the rejections of claims 2, 4, 11, 15-17, 23, 25, 27, 34, 38-40, 46, 52-54, 57, 63, and 65.

Applicants respectfully submit that a *general restatement of the advantages disclosed by the Applicants* deriving from implementation of the present invention may not act as the required teaching or suggestion to combine cited references for a proper rejection under 35 U.S.C. § 103. Courts have repeatedly held that “it is impermissible . . . simply to engage in *hindsight reconstruction* of the claimed invention, using the Applicants’ structure as a template and selecting elements from references to fill in the gaps.” In re Gorman, 18 USPQ 1885, 1888 (CAFC 1991).

Applicants suggest that merely because certain isolated aspects from the cited references produce a beneficial result, this fact alone does not provide the requisite teaching for combining references under 35 U.S.C. §103. Applicants therefore respectfully request the Examiner to provide citations to specific

sections of the cited references that indicate explicit teachings for combining the references, or in the alternative, to withdraw the rejections under 35 U.S.C. §103 so that these claims may issue in a timely manner.

Summary

Applicants submit that the present Response and amendments herein address and overcome the Examiner's rejections. Because the Examiner's citations and arguments do not teach or suggest Applicants' entire claimed invention, and in light of the differences between the claimed invention and the cited prior art, Applicants submit that the claimed invention is patentable over the cited art, and respectfully request the Examiner to withdraw the rejections with regard to claims 1-65 so that the present Application may issue in a timely manner.

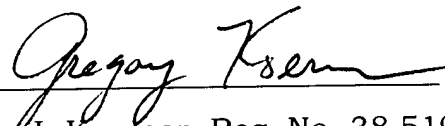
Attached hereto is a marked-up version of the changes made to the claims by the current amendment. The attached page is captioned "Version With Markings To Show Changes Made." If there are questions or comments concerning this amendment, the Examiner is invited to contact Applicants' undersigned representative at the telephone number provided below.

Respectfully submitted,

Date: _____

7/7/03

By: _____



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VERSION WITH MARKINGS TO SHOW CHANGES MADE

In the Claims:

1. (Four-Times Amended) A system for transferring image data to a service provider, comprising:
 - an image source; and
 - an image pump configured to receive said image data from said image source by at least one of a wireless connection, a hard-wired connection, and a form of removable storage, and responsively provide said image data to said service provider, said image pump being implemented separately from said image source and said service provider, in a non-integral manner, for [receiving] transferring said image data from said image source to said service provider, said image pump being implemented in a simplified configuration without an internal processor.

24. (Four-Times Amended) A method for transferring image data to a service provider, comprising the steps of:

capturing said image data utilizing an image source;

sending said image data from said image source to an image pump by at

least one of a wireless connection, a hard-wired connection, and a

form of removable storage, said image pump being implemented

separately from said image source and said service provider, in a non-

integral manner, for [receiving] transferring said image data from said

image source to said service provider, said image pump being

implemented in a simplified configuration without an internal

processor; and

providing said image data to said service provider by utilizing said image

pump.